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JUL 19 2010

OFFICE OF PETITIONS

In re Application of Landschaft : Decision on Petition
Application No. 10/511,463 :
Filing Date: October 14, 2004 :
Attorney Docket No. 15872.212 :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 8, 2010, to revive the above-identified application.

The petition is **dismissed**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(b)."

Facts

As of June 16, 2008, the following individuals were the representatives of record:

1. D. Peter Hochberg,
2. Sean Mellino,
3. Katherine R. Vieyra, and
4. James A. Rich.

The Office mailed a final Office action on June 16, 2008, setting a shortened statutory period for reply of three (3) months. An extension of time under the provisions of 37 CFR 1.136(a) was not obtained. Accordingly, the above-identified application became abandoned on September 17, 2008.

The Office mailed a Notice of Abandonment on May 11, 2009. The notice stated, "On telephonic interview of 05/05/09 Applicant's Representative D. Peter Hochberg confirmed to the Examiner that the application has been abandoned."

The instant petition was filed March 8, 2010. The petition is accompanied by two declarations.

The declaration by Yigal Fatran, an officer of the assignee states,

The [assignee] did not receive a copy of the Office action mailed on October 16, 2008 (the “Office Action”) issued in connection with the above-captioned application. As a result, the Company was not aware of the due date for filing a response to the Office Action ending April 16, 2009, with a three month extension of time....

The entire delay in filing the required reply form the due date for the required reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The declaration by the sole inventor states,

I did not receive a copy of the Office action mailed on October 16, 2008 (the “Office Action”) issued in connection with the above-captioned application. As a result, I was not aware of the due date for filing a response to the Office Action ending April 16, 2009, with a three month extension of time....

The entire delay in filing the required reply form the due date for the required reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The instant petition includes a revocation of the prior power of attorney and power of attorney giving practitioners associated with Customer No. 27887 (Susan Rosenfield, Rodney Fuller, Matthew Seaton) power of attorney in this case.

Discussion

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition “for the revival of an unintentionally abandoned application for a patent.”

37 C.F.R. § 1.137(b)(3) requires a petition under 37 C.F.R. § 1.137(b) to be accompanied by a statement that the entire delay in filing a reply was unintentional. Although a statement will normally be sufficient, 37 C.F.R. § .137(b) states, “The Commissioner may require additional information where there is a question whether the delay was unintentional.”

Prior counsel of record confirmed the abandonment of the application on May 5, 2008, and the petition was filed almost 18 months after the date of abandonment. Therefore, there is a question in this case whether or not the entire delay was unintentional.

Petitioner should note the issue in this case is not whether some of the delay was unintentional; rather, the issue is whether the entire delay *has been shown* to the satisfaction of the Director to be unintentional. In other words, a party filing a petition under 37 C.F.R. § 1.137(b) bears the burden of establishing the entire delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. § 1.137(b). See *In re Application of G*, 11 U.S.P.Q. 2d (BNA) 1378, 1380 (Comm'r Pat. 1989).

The declarations filed with the petition state the assignee and the inventor did not receive the Office action. However, the declarations do not assert the Office action was never received by the practitioners of record.

The declarations state the entire delay was unintentional, but the record indicates Attorney Hochberg was aware of the Office action and the abandoned status at least as early as May 5, 2008, the date he spoke with the examiner.

In view of the prior discussion, the petition fails to establish the entire delay in the filing of a reply to the June 16, 2008 Office action was unintentional. Therefore, the petition is dismissed.

Any request for reconsideration of the instant decision should include a statement from Attorney Peter Hochberg concerning the abandonment of the application. Hochberg's statement should discuss the reason(s) the application became abandoned while it was under his control and discuss any instructions he received from the inventor or the assignee concerning the June 16, 2008 Office action or the status of the application.

Any request for reconsideration of the instant decision should include copies of any correspondence relating to the June 16, 2008 Office action sent from or to Hochberg, the assignee, or the inventor.

If Hochberg intentionally allowed the application to become abandoned due to a failure to receive instructions from the inventor and/or the assignee, any request for reconsideration should discuss the applicability of the following language from *Lawman Armor v. Simon*, 2005 U.S. Dist. LEXIS 10843, 74 U.S.P.Q. 2d (BNA) 1633 (D.E. Mich. 2005) to the instant case:

Plaintiff cites to cases such as *In re Maldaque*, 10 U.S.P.Q. 2d 1477 [(Comm'r Pat. 1988)], and *In re Application of G*, 11 U.S.P.Q. 2d 1378 [(Comm'r Pat. 1988)], for the proposition that the failure of a patent application, acting through his or her representative, to file a required response to a patent office action is a deliberate decision to allow an application to become abandoned, and is not subject to revival under 37 C.F.R. § 1.137(b). Although defendant emphasizes his attorney's inability to contact him, despite multiple mailings, the court notes defendant made a choice to assign a representative to represent him before the USPTO. As plaintiff points out, the USPTO mails correspondence only to the correspondence address or the attorney/agent of record. 37 C.F.R. §§ 1.33(a),(c). That representative confirmed to the USPTO that no steps had been taken to respond to a final office action. The court agrees these were deliberate acts, and cannot be considered unintentional.¹

Statements are required from any and all persons having firsthand knowledge of the circumstances surrounding the lack of a reply to the June 16, 2008 Office action. Therefore, if any party other than the assignee, inventor, and Hochberg has firsthand knowledge of

¹ Id. at *16. The accompanying footnote states, "Plaintiff cites to *Link v. Wabash Railroad Company*, 370 U.S. 626 ... (1962) (*citing Smith v. Ayer*, 101 U.S. 320, 326 ...) and *Irwin v. Department of Veterans Affairs*, 498 U.S. 89, 93 ..., for the proposition that a party is bound by the acts of his or her agent/lawyer."

circumstances surrounding the abandonment of the application, any request for reconsideration should include a statement by the party.

Petitioner should note a petition under 37 C.F.R. § 1.137(b) must establish the *entire* delay in the filing of the petition to revive was unintentional. In other words, even if the initial failure to file a reply was unintentional, the petition cannot be granted if any portion of the delay in filing a petition to revive was intentional. Any request for reconsideration should *fully* discuss the date Hochberg first learned the application was abandoned, the date the assignee first learned the application was abandoned, the date the inventor first learned the application was abandoned, and the delay between the prior dates and May 8, 2010, the date the instant petition was filed.

The petition is accompanied by a payment of \$555 for a three-month extension of time. Payment for an extension of time is unnecessary for relief under 37 C.F.R. § 1.137(b). Specifically, MPEP 711.03(c)(II)(A) states, “A petition for an extension of time under 37 CFR 1.136 and a fee for such an extension of time are not required to be included with the reply.” In addition, the fee cannot be accepted because the extension of time fee was submitted after the expiration of the maximum extendable time period for reply. Therefore, the \$555 fee has been credited back to Deposit Account No. 06-0590.

Unless filed by EFS Web, further correspondence with respect to this matter should be addressed as follows:

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By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
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Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



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